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10/538,336	06/10/2005	Johannis Friso Blacquiere	NL021272	1556
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EXAMINER				
LU'ONG, ALAN H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,336

Applicant(s)

BLACQUIERE ET AL.

Examiner

ALAN LUONG

Art Unit

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Art unit is changed into 2427

Response to Amendment

This Office Action is responsive to the Amendment filed on 09/02/2008.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: because claims 1-17 cited “**pre-recorded**” search instruction which is not disclosed in specification.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-13, and 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0136533 A1 published by Hideo Ando et al. (hereinafter Ando); in view of US 2003/0204848 A1 published by David J. Cheng et al. (hereinafter Cheng)

Regarding claim 1: Fig. 1 of Ando depicts **"a system"** includes **"a recording apparatus [101] to [104]"** for recording programs from **"a receiver "** includes input section [107] and tuner [108] **" that receive receivable programs"** as audio, video and data signals, and in Fig. 9; Ando also discloses **"a comparator"** [MPU 101] compares a primary text information as **"a pre-recorded search instruction"** stored in **"a recordable medium [10]** (i.e. In the program management table (PGI #1), first text information (PRM_TXTI) expressed in alphanumeric characters (e.g., the ASCII code) is recorded and second text information (IT_TXT) is also recorded in the same as or a different language from that of the first text information (PRM_TXTI); (Ando, ¶¶0017-¶0018); furthermore, the first text information (PRM_TXTI) expressed in alphanumeric characters and usable in searching for the programs into the program management table (PGI) on the optical disc; and the second text information (IT_TXT) usable in searching for the programs into an area different from the program management table in the management area on the optical disc; (Ando, ¶¶0025, ¶0029) with **program information** (i.e. inputted text information) **on the receivable programs (Ando, ¶0034)** and further see ¶0028 to ¶0032),(¶103 to¶107) and ¶0130 to ¶145). Finally, Ando also discloses **"a first recording means as means for recording [101-104 of Fig. 1] record a particular one of the receivable programs on the recordable medium; (Ando, ¶0029).**

However, Ando fails to disclose "if a particular one of the receivable programs matches the pre-recorded search instruction stored in the recordable medium [10], the mean for

recording record the particular one of the receivable programs on the recordable medium.

In an analogous art directed toward a similar problem namely improving the results from matching the pre-recorded search instruction. Fig. 3 of Cheng illustrates other record events [232] as a smart record event wherein the user indicates that he or she desires to record all programs that have a " particular one of the receivable programs matches the recorded search instruction stored in the recordable medium".(Cheng, ¶0035, ¶0036)

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify a recording apparatus of Ando with a recording process system as taught by Cheng to prevent conflict at least one already recorded program to free sufficient space to record the program matching".

Regarding claim 2: The system as claimed in claim 1, Fig. 12 of Ando shows "wherein the pre-recorded search instruction comprises **an indication of a specific type of program** (i.e. a search pointer (PL_SRP #) which points at a specific point in the program sequence (VOB sequence) and includes the first text information (PRM_TXTI) **Ando, ¶0023, ¶0180)** to be recorded on the recordable medium (disc 10)"; **also see ¶0177 to ¶0189).** .

Regarding claim 3: merely repeats the limitation of claim 1. So, claim 3 has the same ground rejection as claim 1. (See discussion in claim 1)

Regarding claim 4: The recording apparatus as claimed in claim 3, Fig. 12 of Ando shows "wherein the pre-recorded search instruction comprises **an indication of a specific type of program** (i.e. a search pointer (PL_SRP #) which points at a specific point in the program sequence (VOB sequence) and includes the first text information (PRM_TXTI) **Ando, ¶0023, ¶0180**) to be recorded on the recordable medium (disc 10)"; **also see ¶0177 to ¶0189).** .

Regarding claim 5: The recording apparatus as claimed in claim 4, Fig. 1 of Ando shows further comprising "an information receiver [108] for receiving the program information **indicating a type and times of occurrence of the receivable programs to supply the program information on receivable programs to the comparator** [MPU 101] "(example: the information indicates **a type and times of occurrence of the receivable programs as** the TV program "NONFICTION" on TV channel 12 recorded from 21:00 to 21:59, Jul. 21, 1998, was recorded as program #1 on the disc 10 has been displayed on the TV monitor 113; which shows "98.07.21 21:00-21:59" as an example of the item text and the title of the program "NONFICTION" as an example of the primary text information); **Ando, ¶0122 and ¶0190 to ¶0191).**

Regarding claim 6: The recording apparatus as claimed in claim 5, **wherein the information receiver** (i.e. tuner 108) inputs the text signal into **a teletext receiver [204] for scanning teletext pages containing the program information on receivable programs** (i.e. video signal in video-recording) **(Ando, ¶0135).**

Regarding claims 7, 8: The recording apparatus as claimed in claim 3, Ando reference is deficiency with **"where the recording apparatus** comprising a controller for checking whether a still free space on the recordable medium is sufficient to record the receivable program matching the specific type of program, **for causing the recording means** to record the program matching in the free space, if sufficient, or for causing the recording means **to delete at least one already recorded program to free sufficient space to record the program matching the specific type of the programs"**.

In an analogous art directed toward a similar problem namely improving the results from free space on the recordable medium for recording , Cheng teaches a recording device" further comprising a controller for checking whether a still free space on the recordable medium is sufficient to record the receivable program matching the specific type of program, to record the program matching in the free space, if sufficient, or to delete at least one already recorded program to free sufficient space to record the program matching".(Cheng, ¶0052, ¶0054, ¶0055)

Therefore, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify a recording apparatus of Ando with a recording process system as taught by Cheng to delete at least one already recorded program to free sufficient space to record the program matching".

Regarding claim 8: The recording apparatus as claimed in claim 7, Cheng also teaches a series record event [226] is scheduled the recording device to record each

episode of "the already recorded program", the series record event 226 "comprises a recorded program recorded earliest". **(Cheng, ¶0033)**

Regarding claim 9: The recording apparatus as claimed in claim 3, wherein the recording apparatus [102] is a recorder for recording programs on an optical medium [10], and wherein the programs are TV-broadcast programs **(Ando, ¶0093)**.

Regarding claim 10: The recording apparatus as claimed in claim 3, Fig. 1 of Ando shows "wherein the recording apparatus is a DVD-recorder" **(Ando, ¶0102)**.

Regarding claim 11: The system as claimed in claim 1, Fig. 1 of Ando discloses the recordable medium is a **removable recordable medium** [an optical disc [10] as DVD type], **(¶0201)**, the recording apparatus [101 to 104] further comprises a **storage medium** [105] **(¶0105)**, and the comparator further compares the pre-recorded search instruction with program information on programs recorded on the further storage medium, the recording mean recording on the recordable medium a particular one of the programs recorded only if the particular one of the programs recorded matches the pre-recorded search instruction (see claim 1 rejection).

Regarding claims 12, 13: The recordable medium for use in the system of claim 1, Fig. 1 of Ando depicts the recordable medium [10] comprising the recorded search instruction (i.e. as PRM_TXTI and IT_TXT for searching for the programs into PGI and the management area respectively) **Ando, Figs. 1, 9, ¶0017-¶0025 and ¶0029 to ¶0032)** wherein comprises **an indication of a specific type of program** (i.e. a search pointer (PL_SRP #) which points at a specific point in the program sequence (VOB

sequence) and includes the first text information (PRM_TXTI) **Ando**, ¶0023, ¶0180) to be recorded on the recordable medium (disc 10)"; **also see ¶0177 to ¶0189).**

Regarding claim 16: The method of recording programs on a recordable medium has the same limitation of claim 1. Claim 16 has the same ground rejection of claim 1.

Regarding claim 17: A method as claimed in claim 16, claim 17 has the same limitation of claims 12 and 13. So, claim 17 has the same ground rejection of claims 12 and 13 combination.

3. Claims **14, 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al. (hereinafter Ando) and Cheng et al. (hereinafter Cheng), in view of US 2003/0012562 A1 published by Nabil M. Lawandy et al. (hereinafter Lawandy).

Regarding claim 14: The recordable medium as claimed in claim 12, neither Ando nor Cheng teaches "wherein the recordable medium further comprises a visible marking indicating the pre-recorded search instruction".

In an analogous art directed toward a similar problem namely improving the results from a visible marking indicator; Lawandy teaches "a visible marking indicator" [432] as marking for "the pre-recorded search instruction" (**Lawandy, ¶0088**). Therefore, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify a recording apparatus of Ando and Cheng with a visible marking as taught by Lawandy to provide enhanced identification, authentication and encoding capabilities for various articles of manufacture, including media containing optically readable information. More specifically, a need exists to rapidly produce

images, text, or other optically encoded information on the read side of optical media. Further more, the method should not interfere with the performance of data readout from the optical media. (¶0015)

Regarding claim 15: The recordable medium as claimed in claim 13, neither Ando nor Cheng teaches "wherein the visible marking comprises a text and/or image label indicating the specific type of program to be recorded."

In an analogous art directed toward a similar problem namely improving the results from a visible marking indicator; Lawandy teaches "a visible marking indicator" [432] as marking for a text and/or image label indicating the specific type of program to be recorded." (Lawandy, ¶0054, ¶0098). Therefore, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify a recording apparatus of Ando and Cheng with a visible marking as taught by Lawandy to provide a need exists to rapidly produce images, text, or other optically encoded information on the read side of optical media. Further more, the method should not interfere with the performance of data readout from the optical media. (¶0015)

Response to Arguments

Applicant's arguments filed 09/02/2008 have been fully considered but they are not persuasive.

Applicant points out that no disclosure or suggestion of "comparing the pre-recorded search instruction on the recordable medium with program information on the receivable programs". (Remark, page 10). Examiner respectfully disagrees:

Ando discloses the PRM_TXTI and IT_TXT as recorded search instruction (see **Ando, ¶0017 to ¶0025**); the "recorded" herein including "pre-recorded" in amended claimed as "A search instruction **is recorded** on the recordable medium" disclosed in specification of invention at ¶0007; and in the reproduction unit includes the retrieving section compares the inputted text information with PRM_TXTI which is recorded in the PGI table is stored on the optical disc ; **see Ando, ¶0034**) meets the limitation regarding to" comparing the pre-recorded search instruction on the recordable medium with program information on the receivable programs."

Addition, Applicants submit that Cheng et al. does not disclose the desired program attribute being search information pre-recorded on the recordable medium. (Remark, page 10).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As above discussion, Ando discloses the search information pre-recorded on the recordable medium; Fig. 3 of Cheng illustrates a record event 232 is scheduled program from Set-top box (i.e. scheduler) which is able to search the guide data for these

attributes or characteristics. When a program is found that matches the attributes or characteristics, the program is scheduled as a record event by the scheduler in the priority manager; **see Ando, ¶0035**). Therefore, the examiner's opinion that the combination of Ando and Cheng teach the limitation of "the desired program attribute being search information pre-recorded on the recordable medium"

Finally, Applicants submit that while Lawandy et al. discloses a record carrier containing "markings", there is no disclosure or suggestion that these markings comprise the pre-recorded search instructions, as explicitly claimed in claim 14. (Remark, page 11).

In response to Appellant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. See In re Nomiya, 184 USPQ 607 (CCPA 1975). In this case, the reason for combining references of Ando and Cheng with Lawandy et al. disclose the limitation of "a record carrier containing "markings", wherein comprises the pre-recorded search instructions ". Fig. 4 of Lawandy illustrates an optical disc 420 containing a marking 432 used to display identify information 435 or wherein other necessary information, such as an instruction for a user (i.e. the pre-recorded search instructions as taught by Ando), may remain intact on the non-read side of the optical media 420; see Lawandy, ¶0088).

Therefore, after a careful consideration of the arguments presented, the Examiner must respectfully disagree for the reasons that follow, maintain the grounds of rejection

versus the previously claims, after amended claims 1, 3, 16 dependent claims 2,11-15, 4-10 and 17 respectively, rejection are clarified with the same references.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN LUONG whose telephone number is (571)270-5091. The examiner can normally be reached on Mon.-Thurs., 8:00am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALAN LUONG/
Examiner, Art Unit 2427

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427